

Remarks

Applicants hereby add new claims 21-23. Accordingly, claims 1-23 are pending in the present application.

Claims 1-9, 11-20 stand rejected under 35 USC 102(e) for anticipation over U.S. Patent No. 6,333,790 to Kageyama. Claim 10 stands rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 6,665,089 to Austin et al.

Applicants respectfully traverse the rejections and request allowance of all pending claims.

Applicants have amended the title as indicated herein and respectfully submit that the title corresponds to the preambles of the pending claims and accordingly is highly indicative of the invention to which the claims are directed. Further, the proposed amendment to the title set forth in the Office Action does not refer to any of the claimed methods and accordingly is not clearly indicative of the invention to which the claims are directed. Applicants respectfully request acceptance of the amended title.

Referring to claim 1, the Examiner relies upon the teachings of the spool control part 2130 as allegedly disclosing the dynamic application recited in claim 1 as set forth on pages 2-3 of the Action. The Action also identifies the ROM, RAM and memory devices of Fig. 6 as allegedly disclosing the claimed storage configuration. Applicants disagree with the rejection of claim 1 for at least the following reasons.

Initially, Applicants note the requirements of MPEP §2131, which states that "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM." This MPEP section further states that "'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

More significantly, the elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Action identifies reference teachings as allegedly disclosing limitations of Applicants' claims but fails to provide any identification of teachings which illustrate that the identified reference teachings are arranged as required by the claim pursuant to a proper anticipation rejection.

For example, the action identifies ROM, RAM and memory devices of Fig. 6 as allegedly disclosing the claimed storage configuration and spool control part 2130 as allegedly disclosing the claimed dynamic application. However, claim 1 recites that the **storage configuration is configured to store the dynamic application**. Kageyama is entirely devoid of any teaching or suggestion of the elements arranged as required by claim 1. More specifically, Kageyama is devoid of any disclosure or suggestion of ROM, RAM or memory devices of Fig. 6 storing the hardware spool control part 2130 and accordingly limitations arranged as recited by claim 1 are not shown nor suggested by the prior art.

Further, referring to col. 6 of Kageyama, part 2130 refers to a hardware device to control storage of print jobs and perform spool control operations with respect to the print jobs. The hardware spool control part may receive instructions (e.g., print instructions) but there is no disclosure that the *dynamic application itself comprises executable instructions* as alleged by the Office. There is further no teaching or suggestion in the art that executable instructions of the spool control part *are configured to cause a processor to associate the dynamic application with an instruction component and to perform an operation with respect to the instruction component* as further defined in claim 1. In particular, the Examiner cites the teachings in col. 6, lines 40-65 with respect to the claimed associating with an instruction component and performing of the operation as claimed. Such teachings fail to disclose or suggest the claimed dynamic application. More specifically, the teachings of lines 40-65 merely discuss operations of the print processing part 2140 comprising conventional interfacing of the spooler and engine and fail to disclose or suggest the claimed associating or performing as claimed. Claim 1 is patentable over Kageyama for this additional reason.

Applicants also refer to the *interface configured to **communicate the dynamic application externally of the image forming device*** recited in claim 1. The Action identifies I/F part 602 as allegedly disclosing the above-recited limitations. However, Kageyama is devoid of any teaching or suggestion of I/F part 602

configured to communicate the spooler control part 2130 identified as corresponding to the claimed dynamic application externally of the printer. The teachings identified in the Action fail to disclose or suggest at least the above-mentioned limitations arranged as recited in claim 1 and claim 1 is allowable for at least this reason.

In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements of the prior art which are allegedly arranged as recited in the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if claim 1 is not found to be allowable.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 2 it is stated on page 3 of the Action that the print instructions of Kageyama disclose the claimed components comprising firmware instructions. Applicant submits herewith a copy of a technical dictionary definition of firmware illustrating that a print command may not be fairly interpreted to disclose or suggest the claimed firmware instructions.

Claim 10 stands rejected over Kageyama in view of Austin. Page 6 of the Action states that the combination of reference teachings is proper to reduce operating cost. Applicants submit the motivational rationale is deficient and the 103 rejection is improper for at least this reason.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed.).

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth objective rationale on which it relied. Applicants submit that statements set forth in the present Office Action are akin to the alleged improper motivation discussed *In re Lee* and accordingly are insufficient to combine the reference teachings.

The only motivation presented in the Office Action is based upon *the Examiner's subjective belief or unknown authority which is insufficient as clearly held by the applicable authority*. As set forth by the Federal Circuit, there is no motivation and the Office Action has failed to establish a prima facie case of obviousness and accordingly the 103 rejection is improper.

Applicants submits that the alleged motivation presented by the Examiner would open the door to combinations of any art which would allegedly reduce cost with absolutely no evidence or objective support apart from the bald, conclusory statements of the Examiner. *This is contrary to the authority of the Federal Circuit that motivation may not be based upon the subjective belief of the Examiner or unknown authority.*

There is no evidence of record that modifying Kageyama to perform a Page CRC operation would result in reduced operating cost as alleged in the Action. There is no motivational evidence in the teachings of the prior art. The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

Finally, the Examiner is reminded that claims are analyzed in the context of the *combination of the various separately stated limitations, and not with respect to the limitations individually*. There is no motivation to modify or combine the reference teachings and claim 10 is allowable for at least the above-mentioned numerous reasons.

Referring to claim 12, it is stated on page 4 of the Action that method claim 12 corresponds to apparatus claim 1 and the method claim 1 is inherent and included by the operation of apparatus claim 1. Applicant disagrees with the rejection of claim 12 and the assertion that the limitations of the method claims are inherent and included in the operation of the apparatus claims.

For example, contrary to the CFR, the Office has failed to identify any reference teachings in Kageyama of the *communicating a dynamic application relative to an image forming device* as claimed in claim 12. Kageyama is devoid of any teaching or suggestion of communicating a spooler control part (identified in the Office Action as allegedly disclosing the claimed dynamic application) relative to the

printer of Kageyama and accordingly limitations arranged as required by claim 12 are not shown nor suggested by the prior art.

Kageyama also fails to disclose or suggest the claimed associating the dynamic application with at least one of the instruction components or that a dynamic application includes plural executable instructions configured to cause the processor to perform an operation with respect to an instruction component as claimed.

Further, any assertion that the limitations of claim 12 are inherent from the apparatus teachings is improper. The Office is reminded that, "in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). For example, even though Kageyama may disclose an interface, it does not necessarily flow from the interface teachings that a dynamic application is communicated relative to an image forming device as claimed. Accordingly, the prior art fails to disclose or suggest the limitations arranged as required by claim 12 and claim 12 is allowable for at least this reason.

In accordance with the CFR, Applicants respectfully request clarification of the reference teachings relied upon in support of any rejection of claim 12 in a non-final Action if claim 12 is not allowed so Applicant may appropriately respond.

The claims which depend from independent claim 12 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 20, Applicant disagrees with the 102 rejection over Kageyama. For example, the interface of Kageyama fails to disclose or suggest the claimed *receiving the dynamic application within the image forming device* as claimed. Kageyama fails to disclose or suggest *identifying of the dynamic application after the receiving or the second identifying of the instruction component after the first identifying*. There is no teaching or suggestion in Kageyama of the claimed association of a received dynamic application with the identified instruction component or the establishment of a runtime linkage of the

dynamic application with an API of the identified instruction component as claimed. Kageyama is also devoid of the dynamic application causing the processor to perform an operation with respect to the associated instruction component including storage of data corresponding to the operation as claimed. Numerous limitations of claim 20 are not shown nor suggested by the prior art and claim 20 is allowable for at least this reason. There is also no teaching or suggestion of disabling of the spooler control part identified as allegedly disclosing the claimed dynamic application.

Pursuant to the above, Applicants also traverse any reliance upon inherency in support of the rejection of claim 20 inasmuch as at least the above-recited limitations do not necessarily flow from the Kageyama teachings.

Applicants have added new claims 21-23 which are supported at least by Figs. 2-6 and the associated specification teachings of the originally-filed application.

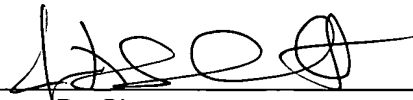
Applicants have submitted the enclosed amendment to correct the informality identified in the specification.

Applicants request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
Cooper Urie et al.

By


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